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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,911	11/06/2001	Jian Ni	PF257D3	4521

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EXAMINER

PATTERSON, CHARLES L JR

ART UNIT PAPER NUMBER

1652

DATE MAILED: 08/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,911

Applicant(s)

NI ET AL.

Examiner

Charles L. Patterson, Jr.

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1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001 and 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 15, 19, 20, 26, 29, 30 and 35-161 is/are pending in the application.
- 4a) Of the above claim(s) 19, 26, 29 and 30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-161 is/are allowed.
- 6) ☒ Claim(s) 1, 15 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Applicant's election with traverse of Group IV in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the search for Groups I-VII would overlap and the search and examination of all of the groups would not be a serious burden. This is not found persuasive because it is maintained that the search for Groups III and V-VII be a serious burden. These groups involve inhibitors, methods of treatments and methods of diagnosis. A search for the polynucleotides, polypeptides and/or antibodies would not involve a search for compounds that inhibit the polypeptide, nor would it involve the diagnosis and treatment methods of Groups V-VII. Also, there are 35 USC § 112 first paragraph matters to be considered in these other groups, in addition to the art rejections, that do not have to be considered in Groups I, II and IV. Since Groups I, II and IV in some form have been allowed in U.S. Patents 6,006,724, 6,174,992 and 6,338,948, claims 1, 15, 20 and 35-161 will be examined

The requirement is still deemed proper and is therefore made FINAL.

Claims 19, 26 and 29-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

In the PTO-1449 submitted, the last two references have been lined out. Parts of what could possibly be U.S. Patent applications have been submitted but there is absolutely no identification as to what applications these are.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re*

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Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61 of U.S. Patent No. 6,006,724. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming sequences that are at least 95% identical with the patented claims and these claims cover 95% identical.

Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-96 of U.S. Patent No. 6,174,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because parts "(a)" - "(c)" meet the requirements of statutory double patenting and part "(d)" falls within the metes and bounds of the claims of the patent.

Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-127 of U.S. Patent 6,338,948. Although the conflicting claims are not identical, they are not patentably distinct from each other because parts "(a)" - "(c)" of claim 15, upon which claim 20 depends, meet the requirements of statutory double patenting and part "(d)" falls within the metes and bounds of the claims of the patent.

Claim 35-161 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone number is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
August 19, 2003